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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,682	01/10/2001	Bruce Beam	05052.00001	4577
22907	7590	09/22/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,682

Applicant(s)

BEAM ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

This is in reference to response received on 10 April 2006. Addition of new claims 27 – 34 is acknowledged. Claims 1 – 8 and 27 – 34 are pending for examination.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). Provisional Application No. 60/194,595 upon which applicant claims priority fails to provide adequate support or enablement for one or more claims of this application. For example, Provisional Application does not provide support for receiving an evaluation of said appraisal from said requester, and, adding said evaluation to said information regarding potential appraisers.

The priority date of the claimed invention will be 10 January 2001, the filing date of the application.

Response to Arguments

Applicant's arguments and concerns in reference to amended claims 1-8 and newly added claims 27-34 have been responded to in response to the pending claims below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite because applicant has not positively claimed what data is used as a determining criteria. Claims 5-6 claim dependency on claim 1.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

using of the results generated from comparing of completed results step.

Claim Rejections - 35 USC §101

Claims 1 – 4, 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must produce concrete and tangible results. In the present case, the claimed invention determines an appraiser using a determining criteria, but, does not positively claim how to determine the

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determining criteria because applicant is not even using the information from the electronic request for a requester to determine the determining criteria. In addition, as claimed in claim 7, comparing completed results against previous results may not produce concrete and tangible results because, comparing an appraisal of a property even within a State but against properties in other counties in that State will not produce concrete and tangible results. Although the recited process produces a useful results, since the claimed invention, as a whole does not produce concrete and tangible results, claims 1-4 and 7-8 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 – 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,758,328 in view of ShowIdeas.com.

Regarding claim, Giovannoli teaches system and method for facilitating a user request for services (for example, request for getting an appraisal service). Giovannoli teaches:

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Receiving an electronic request for an appraisal (type of service) at a hub (means for network buyers to generate request, means for transmitting request to said central processing unit) [abstract] from a requester (it is obvious that a an online order is placed by a requester, purchaser, buyer, customer, client etc.)

Determining an appraiser (service provider) to conduct said appraisal (fulfill the request) using the determining criteria to compare information regarding potential appraisers (Giovannoli teaches filtering for selecting appropriate network members to receive said request for quotation based on filter conditions defined by the buyer in said request for quotation and/or by the vendor and/or by the central processing unit) [abstract, Fig. 2 and disclosure associated with Fig. 2].

Giovannoli does not explicitly teach determination based on previous appraisals from said potential appraisers. However, Giovannoli teaches capability for searching based upon filter conditions. It is obvious that Giovannoli makes selection of potential service providers based on their performance information (for example, selecting one or more appropriate vendors).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Giovannoli can be modified to select one or more appropriate appraisers (vendors) base upon user provided information for service request.

Transmitting electronic information related to said request for appraisal (type of service) to appraiser (selected service provider, Giovannoli teaches selecting one or

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more appropriate vendors to receive the buyer's request for quotation based on filter conditions) [col. 2, lines 61-64].

Receiving electronic information relating to appraising work from said appraiser [col. 3, line 17-20].

Transmitting to said requester a completed appraisal containing information relating to appraising work [Fig. 2 and disclosure associated with Fig. 2].

Giovannoli does not expressly teach receiving an evaluation of said appraisal from said requester, and, adding said evaluation to said information regarding potential appraisers.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving and adding steps would be performed the in the same manner regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive evaluation and add it to the information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

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Even though, Giovannoli does not teach receiving an evaluation of said appraisal from said requester. However, ShowIdeas teaches concept of businesses receiving evaluation of product or services from their customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli as taught by ShowIdeas and collect evaluation of product or services provided to improve on Quality of Service or Product.

Giovannoli in view of ShowIdeas teaches capability for adding said evaluation to said information regarding potential appraisers (Giovannoli teaches storing of information related to vendors).

Regarding claim 4, Giovannoli in view of ShowIdeas receiving electronic information from product or service providers. Giovannoli in view of ShowIdeas is capable of receiving electronic information relating to said appraising work (product or service requested by user) from a communication device operated by said appraiser, said electronic information acceptance or rejection of said request (applicant is claiming content of an electronic information as their invention).

Regarding claims 5, as responded to earlier in response to claim 1, Giovannoli does not specifically teach search criteria to be timeliness of appraisals. However, Giovannoli teaches capability of selecting vendors based on search criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli in view of ShowIdeas and include timeliness of appraisals as a search criteria to improve results of the data query.

Regarding claims 6, as responded to earlier in response to claim 1, Giovannoli does not specifically teach search criteria to be thoroughness of appraisals. However, Giovannoli teaches capability of selecting vendors based on search criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli in view of ShowIdeas and include thoroughness of appraisals as a search criteria to improve results of the data query.

Regarding claim 8, Giovannoli in view of ShowIdeas does not explicitly teach creating performance statistics based on completed appraisals. However, Giovannoli teaches capability of selection and processing of data from a database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Giovannoli in view of ShowIdeas is capable of running query of user defined query criteria (run query to generate performance statistics).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent

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5,758,328 in view of ShowIdeas.com and an article XML By Example Is Here by PeopleSoft hereinafter known as PeopleSoft.

Regarding claim 2, Giovannoli in view of ShowIdeas does not teach to contain XML information. However, PineappleSoft discloses the use of XML in Business to Business and Business to Consumer computer-implement online commerce. PineappleSoft discloses that XML makes it possible for computers at two companies to dialog and automatically exchange information. They can conduct business, at least the costly and slow administrative part of it automatically [PineappleSoft, page 2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli in view of ShowIdeas as taught by PineappleSoft and use XML to make it possible for computers at two companies to dialog and automatically exchange information.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,758,328 in view of ShowIdeas.com and Jost et al. US Patent 5,361,201 hereinafter known as Jost.

Regarding claim 7, Giovannoli in view of ShowIdeas does not expressly teach comparing said completed appraisal against previous appraisals. However, these differences are only found in the nonfunctional descriptive material and are not

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functionally involved in the steps recited. The comparison steps would be performed the in the same manner regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare evaluation, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Even though Giovannoli in view of ShowIdeas does not explicitly teach comparing completed appraisals against previous appraisals, it is inherent that for a requester to give an evaluation of said appraisal, the requester has to compare the appraisal to other appraisals to give a tangible evaluation (it is known to one of ordinary skill in the art at the time the invention was made that appraisals generated by an appraiser comprises appraisals of other compatible properties for comparison and determining appraised value of the property). In addition, Jost teaches concept of comparing completed appraisals against previous appraisals (compares the value range with an appraisal) [Jost, col. 5, lines 35 – 35].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli in view of ShowIdeas as taught by Jost and compare the appraisal against previous appraisals to minimize underwriting loss due to fraudulent appraisals.

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Newly added claims 27-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons.

Claims 1-8 are directed to receiving an electronic request for an appraisal, determining an appraiser to conduct said appraisal using determining criteria, transmitting information to selected appraiser, receiving electronic information relating to appraising work from selected appraiser; transmitting to said requester a completed appraisal; receiving an evaluation of said appraisal from said requester; and, adding said evaluation to said information regarding potential appraisers.

Claims 27-34 are directed to receiving an electronic request for an appraisal, determining an appraiser to conduct said appraisal using determining criteria, transmitting information to selected appraiser, receiving electronic information relating to appraising work from selected appraiser; transmitting to said appraising work a completed appraisal, system analyzing said completed appraisal; and adding a result of said analyzing step to said information regarding potential appraisers.

As shown above, claims 1-8 require human evaluation of the appraisal, whereas, in newly added claims a computer system performs the evaluation which does not require human evaluation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

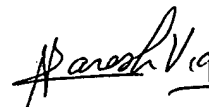
Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
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September 14, 2006